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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/592,254

06/12/2000

Stefano Turri

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04/27/2006

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,254

Applicant(s)

TURRI ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24 and 26-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-24, 26-35, 37, 38, 40 and 41 is/are allowed.
- 6) ☒ Claim(s) 36 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's arguments with respect to claims 17-24, and 26-41 have been considered but are moot in view of the new ground(s) of rejection.

The Status of Claims

Claims 17-24, and 26-41 are pending.

Claims 36 and 39 are rejected.

Claims 17-24, 26-35, 37-38, 40-41 are allowable.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 36, the phrases "m' and n' are integers, m'/n' is in the range 5-40, n' being different from 0; n' can be 0" are recited. In these expressions, the ranges of m' and n' are vague and indefinite because when n' becomes 0, the ratio of "m'/n'" becomes infinite. Also, the meaning of the integers includes the positive numbers and negative numbers, and zero; thus, when m' and n' becomes zero, m'/n' is not in the range 5-40, but in the range of 0/0. Therefore, the examiner recommends to add the specific range for each of m' and n'.

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In claim 36, the phrases " p' and q' are integers, p'/q' is in the range 5 to 0.3, t' is an integer with the meaning of m' ; t' can be zero and $q'/(q'+p'+t')$ is equal to $1/10$ or lower and t'/p' ratio ranges from 0.2 to 6 " are recited. In these expressions, the ranges of p' , q' and t' are vague and indefinite because the meaning of the integers" includes the positive numbers and negative numbers ,and zero; thus, when p' , q' and t' becomes zero each , $q'/(q'+p'+t')$ is not equal to $1/10$ or lower and t'/p' ratio is not in the range of 0.2 to 6. Therefore, the examiner recommends to add the specific range for each of p' , q' and t' .

In claim 39, the phrases " m and n are integers, the m/n ratio is ≥ 2 " and " m , n and q , different from zero are integers" are recited. In these expressions, the ranges of m , n , and q are vague and indefinite because the meaning of the integers includes the positive numbers and negative numbers ,and zero; thus, when m and n becomes zero each , the m/n ratio is not ≥ 2 , but is $0/0$ and the variable q has an unknown range except any integer besides 0. Therefore, the examiner recommends to add the specific range for each of m , n , and q .

In claim 39, the phrase " $\text{HO}(\text{CH}_2\text{CH}_2\text{O})_{x_0}\text{CH}_2$ - type " is recited. The term " type " in the phrase is vague and indefinite because the specification does not elaborate what is meant by the term " type ". Therefore, an appropriate correction is required.

Allowable Subject Matter

Claims 17-24, 26-35, 37-38,40-41 are allowable due to the following reasons:.

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- The rejection of Claims 17, 32-38, and 40-41 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5-10, 12-13, and 27 of U.S. Patent No. 6,579,835 has been withdrawn due to applicants filed the Terminal Disclaimer on 4/7/06.
- The rejection of Claim 40 under 35 USC 112 second, is withdrawn due to the modification made in the claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Taylor Victor Oh
4/25/06